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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,804	05/24/2001	Malcolm Wilson Moon	038602-1153	8901

7590

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/863,804

Applicant(s)

MOON ET AL

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6-8,10-13,20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1,6-8,10-13,20 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |                                                                                             |                                                                             |
|---------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____    |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Claims 1, 6-8, 10-13, 20 and 22 are currently pending in the application and objected. Claims 2-5, 9, 14, 16-19 and 24-36 were cancelled in the amendment filed 7 April 2003 and claim 1 was amended.

### *Election/Restrictions*

The subject matter of claims 1, 6-8, 10-13, 20 and 22 other than that wherein:  
The compound of formula I as found in claim 1 wherein:

R3, R4, R5, R6, R7, R8, R9, R10, and R1' are as found in claim 1, R3' and R4' form an unsubstituted pyrrolidin-1-yl.

It is noted that this generic concept is equivalent to the generic concept as found in the non-final rejection mailed 5 November 2002.

The remaining subject matter of claims 1, 6-8, 10-13, 20 and 22 that is not drawn to the above elected invention stands withdrawn under 37 CFR 1.142(b) as being for non elected subject matter, for reasons essentially those given in the last Office actions. Again.

The remaining compounds which are not within the generic concept, which are independent and distinct from the generic concept and do not have unity with the species elected and therefore are withdrawn by means of a restriction requirement within the claim are, for example, the compounds wherein:

R3' and R4' combine to form a piperazine, a piperidine, a morpholine, an imidazolidine, a tetrahydropyridazine, a tetrahydrofuran, a thiomorpholine, a

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tetrahydropyridine, etc., i.e. R3' and R4' combine to form an unsubstituted heteroalicyclic ring other than unsubstituted pyrrolidin-1-yl.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups which differ from those of the elected invention such as piperazine, imidazolidine, piperidine, morpholine, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclasses 358(+) (piperazine), class 544, subclasses 106(+) (morpholine), class 546 subclasses 184(+) (piperidine), class 548 subclasses 300.1(+) (imidazolidine), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims.

Therefore, Applicants' traversal of the restriction requirement has been considered but is not found persuasive. Applicant argues that the examiner has not examined the elected claims as required by MPEP 803.02. For essentially the same reasons as found in the last Office action, it is noted that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims, which involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. There is no argument or evidence to the contrary. Applicants also argue that there is no burdensome search to search all of the terms as set forth for the compound of formula (I) as found in the instant claim 1 of the amendment filed 7 April 2003. However, this is not found persuasive because the inventions of group I, other than those wherein R3' and R4' form an unsubstituted pyrrolidin-1-yl, are independent and distinct because there is no patentable co-action between the inventions and a reference anticipating one member will not render another obvious. Each invention, i.e. compounds wherein

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R3' and R4' for example, form piperidine, piperazine, morpholine, imidazolidine, tetrahydropyridazine, tetrahydrofuran, thiomorpholine, tetrahydropyridine, etc. is directed to art recognized divergent subject matter, and the groups themselves are inclusive of patentably distinct subject matter, which requires different searching strategies for each group. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner. Accordingly, restriction as has been presented in this application is proper. The requirement to restrict is repeated and made final.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 7 April 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Application No. 10/243663 and US Patent No. 6,451,838 has been reviewed and is accepted. The terminal disclaimer has been recorded. The terminal disclaimer overcomes the Non-statutory double patenting rejection with US Patent No. 6,451,838 and overcomes the provisional non-statutory double patenting with US Patent Application NO. 10/243663.

#### ***Objections***

Claims 1, 6-8, 10-13, 20 and 22 are objected to as containing non-elected subject matter. Claims 1, 6-8, 10-13, 20 and 22 presented drawn solely to the elected invention as identified supra would appear allowable over the prior art of record.

### Conclusion

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

RA

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